REMARKS

Claims 1-24 are pending in the present application. Claims 1, 5, 7-9, 13, 15-17, 21, and 23-24 were amended. Support for the amendments may be found in the specification at least on pages 8-9, 14-18, 21, 24, and 26-27. Reconsideration of the claims is respectfully requested.

I.   Examiner Interview

Applicant thanks Examiner Milef for all the courtesies extended Applicant's representative during the August 23, 2005 telephone interview. During the interview, Applicant's representative discussed the prior art of record and the manner in which the prior art references fail to teach or suggest the features recited in the presently claimed invention. The Examiner indicated she would consider Applicant's comments when submitted. The arguments discussed as well as additional reasons that the claims are allowable over the prior art are set forth in the remarks below.

II.   35 U.S.C. § 103, Obviousness: Claims 1-3, 6-11, 14-19, and 22-24

The examiner has rejected claims 1-3, 6-11, 14-19, and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Ramster (Ramster, Claire. *End of the Paper Chase.* Banking Technology, v14, n6, p32-36, Jul/Aug 1997) (hereinafter *"Ramster"*) in view of AT&T (*AT&T Global's Check Image Feature Expected to Boost Deposits at ATMs.* American Banker, vol. CLIX, n236, p17, Dec. 9, 1994) (hereinafter *"AT&T"*) This rejection is respectfully traversed.

The examiner states on page 3 of the Office Action dated June 20, 2005 that:

Re claim 1: Ramster discloses:
receiving a check image of the check from an automatic teller machine, wherein the check image is generated by a scanner in the automatic teller machine; and performing check clearing processes using the check image and the data. ("Some scanners are located at the point where documents are accepted. For example, scanners are found next to bank tellers and in ATMs to capture images of cheques as they are deposited. Scanners can also have built-in software which automatically processes, recognises [sic] and enters information (such as amounts and account numbers) as the image is scanned.") -see p.2, para. 2,3.
Ramster does not disclose performing optical character recognition on the check image to generate data. AT&T however, discloses ("AT&T Global Information Solutions (Dayton, OH) has released a new automated teller machine (ATM) that displays an image of a check deposited for the customer to see and electronically scans for signatures and amounts for

accuracy and completion. The machine, called a DP-ATM, can also be designed to handle magnetic ink character recognition and optical character recognition...") -see lines 1-6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ramster by incorporating scanning the check image using optical character recognition to generate data, as was done by AT&T, in order to use the data in processing the check, provide information to customers, and increase the speed of processing the check information.

Office Action dated June 20, 2005, page 3.

    1.   **All claim limitations must be considered, especially when missing from the prior art.**

Additionally, in comparing *AT&T* and *Ramster* to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination. Amended independent claim 1, which is representative of other rejected independent claims 9 and 17 with respect to similarly recited subject matter, claims as follows:

    1.   A method in a network data processing system for processing a check, the method comprising:

        receiving a check image of the check from an automatic teller machine, wherein the check image is generated by a scanner in the automatic teller machine;

        performing optical character recognition on the check image to generate data;

        performing check clearing processes using the check image and the data; and

        adding check clearing information to the check image.

The cited references do not teach or suggest "performing check clearing processes using the check image and the data; and adding check clearing information to the check image," as is recited in independent claim 1.

    a)   Adding check clearing information

The cited references fail to teach or disclose "adding check clearing information to the check image," as is now recited in amended independent claim 1. As discussed above, *Ramster* merely teaches processing information scanned from the face of a check for provisional payment or credit of the designated check amount. *Ramster* does not teach, suggest, or even mention

clearing a check or adding check clearing information to a check image, as is claimed in amended claim 1.

AT&T is directed towards an ATM machine that scans a check and displays an image of the deposited check for a customer to view. *AT&T* teaches:

> When a customer deposits a check into the new ATM, an image of the item is scanned by a special camera and projected on the terminal screen. The check does not require a deposit envelope.

> After the customer keys in the amount of the check, the ATM uses character recognition technology to confirm the presence of signature on the check. It also reads the courtesy amount from the item and compares this to the dollar amount the consumer has entered.

AT&T, page 2, paragraphs 1 and 2.

Here, *AT&T* merely teaches scanning a check at an ATM and confirming the presence of signatures on the check. The check amount is also read and compared to the amount entered by the consumer at the ATM. However, *AT&T* does not teach, suggest or even mention clearing a check or "adding check clearing information to a check image" in this or any other section of the reference.

b)   Performing check clearing processes

The Examiner believes this feature is taught by *Ramster* at p.2, para. 2,3. *Ramster* teaches as follows:

> For whatever application you use with imaging, you need a scanner (or a device which incorporates a scanner) to take a picture of the paper-based information. Some scanners are located at the point where documents are to capture images of cheques as they are deposited.

> Scanners can also have built-in software which automatically processes, recognizes and enters information (such as amounts and accounts numbers) as the image is scanned. Bell & Howell's Copiscan Image 8000 Series of scanners, due to be launched later in the year, offer information recognition capabilities. These scanners are embedded with a new version of information recognition and forms processing.

Ramster, p.2, paragraph 2 and 3.

As shown above, *Ramster* teaches that scanners located in ATMs can capture images of checks. The scanners automatically process, recognize, and enter information as the check is scanned. Thus, *Ramster* merely teaches scanning information on the face of a deposited check,

processing that information, and entering the information. *Ramster* teaches that examples of information scanned on the check include the amount and account numbers on the check. The process described by *Ramster* is presentment of a check to payee's financial institution. Typically, payee's financial institution will provide provisional credit or payment of a check amount prior to clearing the check through the Federal Reserve System and sending the check to payer's financial institution for acceptance and payment. *See Doggett*, column 1, lines 44-52.

In contradistinction, the present invention as recited in amended claim 1 claims "performing check clearing processes using the check image and the data." Thus, the teachings of *Ramster* regarding scanning a check to obtain information on the face of the check regarding the check amount and account numbers is not sufficient to teach "performing check clearing processes using the check image," as is claimed in claim 1.

Thus, neither *Ramster* nor *AT&T* teach or suggest "performing check clearing processes using the check image and the data; and adding check clearing information to the check image," as is now recited in amended independent claim 1. Therefore, claim 1 is not obvious in view of *AT&T* and *Ramster* because the features believed to be disclosed by the cited references are not present.

2.   **Stating that it is obvious to try or make a modification or combination without a suggestion in the prior art is not *prima facie* obviousness.**

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir 1989); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Examiner may not merely state that the modification or combination would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

The present invention in claim 1 includes the feature of performing check clearing processes using a check image and adding check clearing information to a check image. In contrast, *Ramster* and *AT&T* teach scanning information on a check face at the time payee presents check for deposit and processing the scanned information from the check but does not teach check clearing processes or adding check clearing information to a check image. Thus, it

would not have been obvious to combine the references to reach the presently claimed invention in claim 1 because the prior art does not teach or suggest performing check clearing using a check image and adding check clearing information to a check image, as in the present invention in claim 1.

The Examiner states it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified *Ramster* by incorporating scanning the check image using optical character recognition to generate date, as was done by *AT&T*, in order to use the data in processing the check, provide information to customers, and increase the speed of processing the check information. However, even if it would have been obvious to combine *Ramster* and *AT&T* to scan a check using optical character recognition to increase the speed of processing check information for provisional payment or credit to payee's account in the designated amount of the check, neither of the references teaches or suggests performing check clearing processes and adding check clearing information to a check image. Therefore, it would not have been obvious to combine and modify *Ramster* and *AT&T* to perform check clearing processes and add check clearing information to a check image.

3. Even if the references could be properly combined, the combination of the references would not form the presently claimed invention.

The present invention is directed towards processing a check image by performing check clearing processes using a check image and data; and adding check clearing information to the check image. Even if *Ramster* and *AT&T* could be properly combined, a combination of the references would not form the presently claimed invention in claim 1. Instead, a combination of *Ramster* and *AT&T* would result in scanning a check using a scanner and optical character recognition to recognize and enter information on the check face when the check is deposited and allow customers to view a digital image of the deposited check. However, the combination of *Ramster* and *AT&T* would not result in the combination of features recited in amended claim 1.

4. The presently claimed invention may only be reached through an improper use of the disclosed invention as a template to piece together and modify the prior art.

Moreover, the Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered

obvious. *In re Fitch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, *Ramster* and *AT&T* cannot be properly combined to form the claimed invention. As a result, absent any teaching suggestion or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes.

In addition, absent some teaching, suggestion, or incentive in the prior art, *Ramster* and *AT&T* cannot be properly modified to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed modification, the presently claimed invention can only be reached through an impermissible use of hindsight with the benefit of Applicant's invention as a model.

Thus, amended independent claim 1 is not obvious over the prior art of reference. Other rejected independent claims 9 and 17 recite subject matter addressed above with regard to claim 1 and are allowable over the prior art of reference under the same rationale set forth above with regard to claim 1. At least by virtue of their dependency on independent claims 1, 9, and 17, dependent claims 2-3, 6-8, 10-11, 14-16, 18-19, and 22-24 are allowable over the prior art of reference. In addition, dependent claims 2-3, 6-8, 10-11, 14-16, 18-19, and 22-24 recite additional combinations of features not taught or suggested by the prior art references.

For example, amended dependent claims 7, 15, and 23 now claim adding check clearing information to the check image comprises "adding overlay prints providing information regarding at least one of an identification of a financial institution clearing a check, a name of a financial institution; a transaction number; a type of transaction; and a date of a transaction." As discussed above, *Ramster* and *AT&T* do not disclose adding check clearing information. Nor do the references teach, suggest or even mention "adding overly prints" of any kind to a check image. Therefore, *Ramster* and *AT&T* fail to teach or suggest "adding overlay prints providing information regarding at least one of an identification of a financial institution clearing a check, a name of a financial institution; a transaction number; a type of transaction; and a date of a transaction," as is recited in dependent claims 7, 15, and 23.

Regarding amended dependent claims 8, 16, and 24, dependent claim 8, which is representative of other rejected dependent claims 16 and 24 with respect to similarly recited subject matter, now recites as follows:

> 8. The method of claim 1, wherein the step of performing check clearing processes occurs at a clearinghouse, and wherein the clearinghouse performs check settlement.

As discussed above with regard to independent claim 1, the cited references fail to teach or suggest performing check clearing processes using the check image and the data," as is claimed in independent claim 1. In addition, neither *AT&T* nor *Ramster* teaches or suggests "the step of check clearing processes occurs at a clearinghouse." As discussed above, *Ramster* and *AT&T* merely teach scanning and performing optical character recognition on a check at an ATM to capture an image of a check. However, such teachings are insufficient to teach or suggest check clearing occurs at a clearinghouse, as is claimed in claims 8, 16, and 24.

Furthermore, the cited references fail to teach or suggest that a "clearinghouse performs check settlement," as is now recited in amended dependent claims 8, 16, and 24. As shown above, the cited references merely teach an ATM scans a check and performs optical character recognition on a deposited check. Neither *AT&T* nor *Ramster* teaches, suggests or even mentions a clearinghouse performs check settlement. Thus, *AT&T* and *Ramster* fails to teach or suggest "performing check clearing processes occurs at a clearinghouse, and wherein the clearinghouse performs check settlement," as is recited in dependent claims 8, 16, and 24.

Therefore, the rejection of claims 1-3, 6-11, 14-19, and 22-24 under 35 U.S.C. § 103(a) has been overcome.

III. 35 U.S.C. § 103. Obviousness: Claims 4, 12, and 20

The examiner has rejected claims 4, 12, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Ramster* in view of *AT&T* as applied to claims 1, 9, and 17 above and in further view of Jones (U.S. Patent Publication No. US-2002/0145035) (hereinafter "*Jones*"). This rejection is respectfully traversed.

The examiner states on page 7 of the Office Action dated June 20, 2005 that:

> Re claim 4: Ramster and AT&T do not disclose:
> the check image includes a front side and a back side of the check. Jones however, teaches ("When the document moves into a position 76b, the image of

one of the first or second sides of the document travels along a first path 72 to a mirror 70. The image is then reflected by the mirror 70 along a second path 74 to a scanhead 80. The scanhead 80 is rotatable as shown. Thus, one side of the document is imaged using reflection techniques.

The document 61 then moves into position 76c where the image of the other of the first and second sides of the document is scanned by the scanhead 80.")-see p. 4, para. 46,47. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ramster and AT&T by incorporating that the check image include a front side and a back side of the check in order to access valuable information such as endorsement information and bank information.

Claims 12 and 20 have similar limitations found in claim 4 above, therefore are rejected by the same rationale.

Office Action dated June 20, 2005, page 7.

As discussed above with regard to independent claim 1, *Ramster* and *AT&T* fail to teach or suggest "performing check clearing processes using the check image and the data" and "adding check clearing information to the check image," as is now recited in amended independent claims 1, 9, and 17. *Jones* is directed towards scanning checks to obtain a full image of the checks fed into the document scanner. *Jones* teaches:

> An automated check processing system for accepting and processing checks from a customer, having a plurality of document scanners. The document scanners are adapted to obtain full images of checks fed into the document scanners and to obtain images of selected portions of the checks. A printer may be included for printing an authorization agreement on the checks and for inscribing a transaction amount on the checks. The system also utilizes a conveyor for returning the checks with the agreement to the customer for signing. The image scanned is then communicated to a central clearinghouse via a communication link.

Jones Abstract.

However, *Jones* does not teach or suggest "performing check clearing processes using the check image and the data" and "adding check clearing information to the check image," as is recited in independent claims 1, 9, and 17. *Jones* fails to make up for the deficiencies of *Ramster* and *AT&T.* Thus, any proposed combination of *Ramster, AT&T* and *Jones* does not teach or suggest the combination of features recited in independent claims 1, 9, and 17.

Therefore, at least by virtue of their dependency on claims 1, 9, and 17, dependent claims 4, 12, and 20, are not obvious over any proposed combination of *Ramster*, *AT&T* and *Jones*. Therefore, the rejection of claims 4, 12, and 20 under 35 U.S.C. § 103(a) has been overcome.

IV.   35 U.S.C. § 103, Obviousness: Claims 5, 13, and 21

The examiner has rejected claims 5, 13, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Ramster* in view of *AT&T* as applied to claims 1, 9, and 17 above and in further view of Doggett et al. (U.S. Patent No. 5,677,955) (hereinafter "*Doggett*"). This rejection is respectfully traversed.

The examiner states on page 8 of the Office Action dated June 20, 2005 that:

> Re claim 5: Ramster and AT&T do not disclose:
> performing check clearing processes includes:
> adding overlay prints showing who is clearing the check. Doggett et al. disclose (Also appended to the instrument may be digital representations of a verifiable signature of the payee, a verifiable certificate by an institution which holds an account of the payee, and a verifiable certificate by a central banking authority with respect to the institution which holds the payee's account.") -see col.3, lines 30-35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ramster and AT&T by incorporating that the check clearing process include adding overlay prints or a "verifiable certificate" as stated by Doggett et al. in order to provide a record of the institution who is clearing the check.
> Claims 13 and 21 have similar limitations found in claim 5 above, therefore are rejected by the same rationale.

Office Action dated June 20, 2005, page 8.

As discussed above with regard to independent claim 1, *Ramster* and *AT&T* fail to teach or suggest "performing check clearing processes using the check image and the data" and "adding check clearing information to the check image," as is now recited in amended independent claims 1, 9, and 17. *Doggett* is directed towards creating an electronic document for effecting transfer of funds from a payer account to a payee. *Doggett* teaches:

> An electronic instrument is created in a computer-based method for effecting a transfer of funds from an account of a payer in a funds-holding institution to a payee. The electronic instrument includes an electronic signature of the payer, digital representations of payment instructions, the identity of the payer, the identity of the payee, and the identity of the

funds-holding institution. A digital representation of a verifiable certificate by the institution of the authenticity of the instrument is appended to the instrument. This enables a party receiving the instrument, e.g., the payee or a bank, to verify the authenticity of the account or account holder. The invention may be generally applied to any financial electronic document.

Doggett, abstract.

Doggett does not teach or suggest "performing check clearing processes using the check image and the data" and "adding check clearing information to the check image," as is recited in independent claims 1, 9, and 17. Therefore, *Doggett* fails to make up for the deficiencies of *Ramster* and *AT&T*. Thus, any proposed combination of *Ramster*, *AT&T* and *Doggett* does not teach or suggest the combination of features recited in independent claims 1, 9, and 17. Moreover, at least by virtue of their dependency on claims 1, 9, and 17, dependent claims 5, 13, and 21 are not obvious over any proposed combination of *Ramster*, *AT&T* and *Doggett*.

Moreover, the combination of *Ramster*, *AT&T* and *Doggett* fails to teach or suggest "adding overlay prints providing check clearing information" as is recited in claims 5, 12, and 21. Amended dependent claim 5, which is representative of other rejected dependent claims 13 and 21, recites as follows:

> 5.   The method of claim 1, wherein the step of adding check clearing information to the check image comprises:
>   adding overlay prints providing check clearing information, wherein check clearing information includes an identification of a financial institution clearing the check; a name of a financial institution clearing a check; a transaction number; a type of transaction and a date of transaction.

The Examiner acknowledges that *Ramster* and *AT&T* do not disclose adding overlay prints showing who is clearing the check. However, the Examiner believes *Doggett* teaches adding overly prints at column 3, lines 30-35. *Doggett* teaches as follows:

> Also appended to the instrument may be digital representations of a verifiable signature of the payee, a verifiable certificate by an institution which holds an account of the payee, and a verifiable certificate by a central banking authority with respect to the institution which holds the payee's account.

Doggett, column 3, lines 30-35.

Here, *Doggett* merely teaches that a verifiable certificate may be appended to an electronic instrument. However, this portion of *Doggett* does not teach "adding an overlay print providing information providing check clearing information" as is recited in claim 5. *Doggett* also teaches:

> The electronic check is an electronic financial instrument which in some respects mimics the paper check. It is initiated and routed electronically, uses digital signatures for signing and endorsing, and relies on digital cryptographic certificates to authenticate the payer and payee and their respective banks and bank accounts and to provide a degree of security to all parties to the transaction.

Doggett, column 7, lines 13-20.

As shown above, *Doggett* merely teaches that digital cryptographic certificates are used to authenticate a payer or payee's signature on an electronic check and their respective bank accounts. The certificate may be appended to the electronic check.

The teachings of *Doggett* regarding check clearing are as follows:

> The payee's bank 78 receives the endorsed instrument 74 deposited by the payee 14, validates both the payee's digital signature of endorsement and the payer's original digital signature using public key cryptography, verifies that the instrument 74 is not a recent duplicate and that the date of the instrument 74 is valid and checks the certificates. The payee's bank 78 then credits the sum of money specified in the instrument 74 to the payee's account and clears the instrument 74 with the payer's bank 82 via existing electronic settlement procedures, e.g., bilateral arrangement, ECP, ACH, ATM, EFT, or check imaging. The settlement procedures are carried out over a network 80 connecting the computers of a large number of banking institutions, the network 80 itself indirectly connected with the public network 65.
>
> After clearance of the instrument, the payer's banking institution 82 receives the processed instrument 74. The payer's bank 82 validates both the payer's and the payee's signatures using public key cryptography. The payer's bank

Doggett, column 8, lines 19-36.

Doggett teaches that payee's bank receives an instrument, validates both payee and payer's signatures, checks the certificates, provisionally credits the sum to payee, and then clears the instrument with the payer's bank. *Doggett* does not provide any teaching or suggestion for adding an overlay print providing check clearing information. Thus, the teachings of *Doggett* are

insufficient to make up for the deficiencies of *Ramster* and *AT&T*. Therefore, claims 5, 13, and 21 are not obvious in view of *Ramster*, *AT&T*, and *Doggett* because the features believed to be disclosed by these references are not present.

Therefore, the rejection of claims 5, 13, and 21 under 35 U.S.C. § 103(a) has been overcome.

V.   Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: September 13, 2005

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